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170 Wood Avenue South
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EXAMINER

FRENEL, VANEL

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PAPER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte R. BHARAT RAO,
RADU STEFAN NICULESCU, and
SATHYAKAMA SANDILYA

Appeal 2009-012761
Application 10/727,197
Technology Center 3600

Decided: November 24, 2009

Before HUBERT C. LORIN, ANTON W. FETTING, and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

R. Bharat Rao, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-51. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and enter a new ground of rejection pursuant to 37 CFR § 41.50(b).¹

THE INVENTION

The invention “relates to systems and methods for automated processing of medical information in electronic patient medical record databases.” Specification 1:6-7.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A method for processing medical information, comprising the steps of:
 - obtaining a medical record of a patient, wherein the medical record comprises patient information from structured and unstructured data sources;
 - analyzing with a computer the patient information from at least the unstructured data source in the medical record using domain-specific criteria; and
 - automatically extracting billing information from the medical record as part of the analysis.

¹ Our decision will make reference to the Appellants’ Appeal Brief (“App. Br.,” filed Apr. 20, 2007) and Reply Brief (“Reply Br.,” filed Oct. 22, 2007), and the Examiner’s Answer (“Answer,” mailed Dec. 24, 2008).

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Evans US 6,347,329 B1 Feb. 12, 2002

Harvin et al., "Managed Care: New Financial/Practice Strategies to Manage More Efficient/Effectively in a Primary Care Setting," Nursing Administration Quarterly, Frederick, Spring 1998, Vol. 22, Iss. 3, p. 53, 6 pp. (Harvin)

"iMedica Creates the Most Comprehensive Charting Solution Harnessing the Power of the Internet Wirelessly, PR Newswire, New York, Jan. 18, 2000, p. 1. (PR Newswire)

The following rejections are before us for review:

1. Claims 25-38 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.
2. Claims 1-51 are rejected under 35 U.S.C. §103(a) as being unpatentable over Evans, Harvin, and PR Newswire.

DISPOSITION OF THE APPEAL

The Examiner entered a new ground of rejection in the Examiner's Answer against claims 25-38 under 35 U.S.C. §101 as being directed to non-statutory subject matter. Answer 3. The Examiner properly gave notice of the new ground of rejection (Answer 32) and the Technology Center Director approved it. Answer 33. As the Answer indicated (Answer 32), the Appellants were required to respond to the new grounds within two months in either of two ways: 1) reopen prosecution (*see* 37 CFR 41.39(a)(2)(b)(1)); or 2) maintain the appeal by filing a reply brief as set forth in 37 CFR 41.41

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(see 37 CFR 41.39(a)(2)(b)(2)), “to avoid *sua sponte* dismissal of the appeal as to the claims subject to the new ground of rejection.” Answer 32.

According to the record before us, neither option appears to have been exercised.

Accordingly, the appeal as to claims 25-38, subject to the new ground of rejection under §101 as being directed to nonstatutory subject matter stands dismissed.

Upon return of the application to the Examiner, the Examiner should (1) cancel claims 25-38 subject to the new ground of rejection and (2) notify the Appellants that the appeal as to claims 25-38, subject to the new ground of rejection under §101, as being directed to nonstatutory subject matter, is dismissed and claims 25-38 are cancelled. See Manual of Patent Examining Procedure (MPEP) § 1207.03, 8th ed., Rev. 7, Jul. 2008.

Given that the appeal as to claims 25-38 stands dismissed, the rejections before us for review are reduced to as follows:

1. Claims 1-24 and 39-51 are rejected under 35 U.S.C. §103(a) as being unpatentable over Evans, Harvin, and PR Newswire.

ISSUES

The issue is whether the Appellants have shown error in the Examiner’s rejection of claims 1-24 and 39-51 under 35 U.S.C. §103(a) as being unpatentable over Evans, Harvin, and PR Newswire. There is also the issue of the statutory status of the subject matter of claims 46-51, which claims depend from dismissed claim 25.

PRINCIPLES OF LAW

Obviousness

Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’

KSR Int’l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *Graham*, 383 U.S. at 17-18.

ANALYSIS

Independent process claim 1 calls for steps of conducting a computer analysis of patient information in a medical record from an unstructured data source using domain-specific criteria and automatically extracting billing information from the medical record as part of that analysis. Independent claims 39 calls for a device embodying a program of instructions to perform

these steps.

The Examiner's position is that Evans discloses a medical record with patient information from an unstructured data source; Harvin discloses extracting billing information from a medical record; and, PR Newswire "suggests that the method having [sic, of ?] analyzing with a computer the patient information from at least the unstructured data source in the medical record using [sic, uses?] domain-specific criteria" (Answer 6) and that one of ordinary skill in the art would arrive at the claimed subject matter by combining these disclosures. Answer 5-6.

First, the Examiner's characterization of what Harvin discloses is not accurate. We can find nothing in the reference about "extracting" billing information from a medical record. We do see mention of billing information but not "extracting" it. Second, the Examiner's characterization of what PR Newswire discloses is also not accurate. We see discussion of a charting solution that creates electronic records for patient visits and provides a knowledgebase comprising documentation of patient encounters. However, we can find nothing in PR Newswire about computer analyzing patient information from an unstructured data source in a medical record using domain-specific criteria. There appears to be no disclosure of analyzing any information from an "unstructured data source" using domain-specific criteria ("Unstructured information" is exemplified in the Specification (pp. 9-10) by free-text based reports, images, waveforms, and physician notes.) (The Specification defines "domain specific" as a medical diagnosis. Specification 12:9.)

Accordingly, the Examiner's prima facie case of obviousness is deficient. We do not find that one of ordinary skill in the art would arrive at

the claimed process comprising steps of conducting a computer analysis of patient information in a medical record from an unstructured data source using domain-specific criteria and automatically extracting billing information from the medical record as part of that analysis from disclosures of a medical record with patient information from an unstructured data (Evans), billing information (Harvin), and a charting solution that creates electronic records for patient visits and provides a knowledgebase comprising documentation of patient encounters (PR Newswire). We reach the same conclusion as to the device embodying a program of instructions to perform these steps as set forth in claim 39.

Accordingly we reverse the rejection under §103 of independent claims 1 and claims 2-24, 43-45 that depend on claim 1, and claim 39 and claims 40-42 that depend on claim 39.

We now turn to claims 46-51. Claims 46-48 depend from claim 25. The Appeal Brief indicates that claims 49-51 depend from claim 38. Claim 38 depends on claim 25. (We note that the Examiner has stated that the copy of the claims contained in the Appendix to the Appeal Brief is correct. Answer 4). Accordingly we will address claims 46-51 together as depending from claim 25 and including the claim 25 limitations. Albeit the appeal of claim 25 has been dismissed (*see supra*), claim 25 limits the engine of the claimed system to require it to operate in accordance with the same steps as those set forth in claim 1. This limitation therefore also applies to claims 46-51. Therefore since we have found that a prima facie case of obviousness has not been established for the subject matter of claim 1 on the ground that the claim steps are not disclosed in the cited prior art and one of ordinary skill in the art would not have arrived at the claimed method given the prior

art disclosures, we necessarily reach the same conclusion as to subject matter of claims 46-51.

NEW GROUND OF REJECTION

Pursuant to 37 CFR § 41.50(b), we enter a new ground of rejection. We reject claims 46-51 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

These claims ultimately depend on claim 25 which the Examiner construed as being “directed to nothing more than a program code per se and in non-statutory.” Answer 3. The Appellants have not challenged that construction. Given the nature of computer programs as lists of instructions, the Examiner was reasonable to take the position that, being directed to “program code,” the subject matter of claim 25-38 did not appear to fall in any of the statutory categories of patentable subject matter set forth in §101. We know of no legal authority that is binding precedent on the Board which holds computers programs per se to be patentable subject matter under §101. In fact, current Office policy supports the Examiner. *See* U.S. Patent & Trademark Office, Interim Examination Instructions for Evaluating Subject Matter Eligibility under 35 U.S.C. § 101, Aug. 2009, at 2, available at http://www.uspto.gov/patents/law/comments/2009-08-25_interim_101_instructions.pdf. The subject matter of claims 46-51 adds nothing structural to the “program code” of claim 25. Accordingly, claims 46-51 should be treated the same way. Since the subject matter of claims 46-51 adds nothing structural to the “program code” of claim 25, we reach the same conclusion as to these claims as the Examiner reached with respect to claims 25-38. Claims 46-51 are rejected under 35 U.S.C. § 101 as being

directed to non-statutory subject matter.

CONCLUSIONS

We conclude that the Appellants have shown that the Examiner erred in rejecting claims 1-24 and 39-51 under 35 U.S.C. §103(a) as being unpatentable over Evans, Harvin, and PR Newswire.

We enter a new ground of rejection of claims 46-51 under 35 U.S.C. §101.

DECISION

The decision of the Examiner to reject claims 1-24 and 39-51 is reversed. We enter a new ground of rejection of claims 46-51 under 35 U.S.C. §101.

This decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the Appellants, **WITHIN TWO MONTHS FROM THE DATE OF THE DECISION**, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) Reopen prosecution. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which

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event the proceeding will be remanded to the examiner

- (2) Request rehearing. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

REVERSED; 37 C.F.R. § 41.50(b)

MP

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